



UNITED STATES PATENT AND TRADEMARK OFFICE

3
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,467	12/27/2001	Hidehei Kagevarna	NO. 49	7790

7590 01/15/2003

McGinn & Gibb, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817

EXAMINER

PRUNNER, KATHLEEN J

ART UNIT	PAPER NUMBER
----------	--------------

3751

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/026,467	Applicant(s) Kagevarna et al.
	Examiner Kathleen J. Prunner	Art Unit 3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Dec 27, 2001

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on Dec 27, 2001 is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2

4) Interview Summary (PTO-413) Paper No(s). _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

Art Unit: 3751

DETAILED ACTION

Drawings

1. ^{drop} The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference signs mentioned in the description: 23 and 24 (note page 14 of the specification). A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. ^{drop} The drawings are objected to as failing to comply with 37 CFR 1.84(h)(2) because brackets are needed to show the figure as one entity in Figs. 3, 16, 17, 22 and 27. A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. ^{drop} The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the external thread of the ancillary sleeve engaging the internal thread of the intermediate sleeve, as called for by claims 11 and 17, must be shown or the feature(s) canceled from the claims. No new matter should be introduced or it will not be entered. A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
4. ^{drop} The drawings are objected to because Figs. 12 and 13 fail to show "32c" as "an internal thread formed on an inner circumferential face of the intermediate sleeve 32" (note lines 6-7 on page 18). A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
5. Applicant is required to submit a proposed drawing correction **in reply to this Office action** in order to avoid abandonment of the application. Any proposal by the applicant for amendment of

Art Unit: 3751

the drawing to cure defects **MUST** be embodied in a **SEPARATE LETTER to the Draftsman**.

See MPEP §608.02(r). The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. ^{drop} With regard to claims 1, 6 and 20, the “plurality of holders” (on line 2 of claims 1 and 20, line 5 of claim 6, and in claims 2 and 3, etc.) is inferentially included as part of the claimed combination of elements rendering the claims indefinite as to whether the combination of a plurality of holders and a composite holding device or the subcombination of a composite holding device is intended to be claimed. Should applicant intend the “plurality of holders” to be a positive element of the claimed combination, then positive structural antecedent basis should be provided therefore. If not, the terminology “adapted to be” could be used (i.e., at lines 8-10 in claim 1, the manipulating mechanism being adapted to project a tip of one . . .; at lines 11-12 in claim 1, the supporting section being adapted to support a section of each holder . . .; and, at lines 2-3 in claim 2, a spherical bearing adapted to be formed between . . ., etc., etc.).

9. ^{beep} Claim 1 contains terms lacking proper antecedent basis. The claim recites the limitations “the tip” of one of the plurality of holders and “the tip” of the casing in lines 8-10. There is insufficient antecedent basis for these limitations in the claim.

Art Unit: 3751

10. Claim 6 contains terms lacking proper antecedent basis. The claim recites the limitations “the tip” of one of the plurality of holders and “the tip” of the casing in lines 11-13. There is insufficient antecedent basis for these limitations in the claim.

11. Claim 20 contains terms lacking proper antecedent basis. The claim recites the limitations “the tip” of one of the plurality of holders and “the tip” of the casing in lines 5-7. There is insufficient antecedent basis for these limitations in the claim.

12. Claims 11 and 17 contain terms lacking proper antecedent basis. The claims recite the limitations “the internally threaded part” in lines 6, 10-11 and 15, and “the externally threaded part” in line 10. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-10 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schleif. Schleif discloses a composite holding device having all the claimed features including a casing (constituted by bottom part 1 and top part 2) accommodating a plurality of holders or holder bodies (constituted by writing cartridges 22 and 23) holding media (ball point pens), a supporting section (constituted by guide tube 8) for supporting the holders, a feed mechanism (constituted by slides 13 and cam surface 19) provided in the casing for selectively advancing one of the plurality of holders, and a manipulating mechanism (constituted by the barrel part 1) for operating the feed mechanism and to project the tip of one of the writing cartridges out of the end of the casing (note Fig. 1). The introductory statement of intended use and all other functional recitations of intended use have been

Art Unit: 3751

carefully considered but are deemed not to impose any structural limitations on the claim distinguishable over that shown by Schleif which is certainly capable of being used in the intended manner if one desires to do so. With respect to claims 2 and 8, Schleif also discloses a spherical bearing constituted by the spherical top of slides 13 (note Fig. 8). With regard to claims 3 and 9, Schleif further discloses that the spherical part is formed on a supported section and a concave part is formed by the curved cam surface 19 (note Fig. 1). With regard to claims 4 and 10, Schleif additionally discloses that the media is a writing related media of ink normally used by ball point pens (note lines 6-7 in col. 1). With respect to claims 5 and 6, Schleif further discloses that the composite holding device has a cap constituted by the bottom part 1 of the casing.

Allowable Subject Matter

15. Claims 11-19 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action and if claims 11, 14 and 16-19 if rewritten to include all the limitations of the base claim and any intervening claims.

Conclusion

16. The Examiner is advising attorneys to FAX any response due to Office actions. The U. S. Patent and Trademark Office (USPTO) is experiencing major delays in matching up papers that were mailed. Due to the Anthrax issue, any mail sent to the USPTO is automatically sent to an irradiation center in Virginia. It has been found that the irradiation process makes papers too brittle to handle. Therefore, the irradiation center has to further copy each paper. The originally filed irradiated papers are then placed in a sealed envelope and put in the associated file. After this irradiation process, the "papers" are then sent to the Office where they are matched with the file. This entire procedure causes months in delays due to the quantity of mailed received. Therefore, it is suggested that any

Art Unit: 3751

response be sent by FAX especially if a time limit is critical. The FAX number for the technical center where this file is located is given in the paragraph below.

17. Any inquiry concerning this communication from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044. Although the examiner participates in the maxi-flex program, she can usually be reached Monday through Friday from 5:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson, can be reached on 703-308-2580. The FAX phone number for the organization where this application is assigned is 703-308-7766.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0861.


Kathleen J. Prunner

Kathleen J. Prunner:kjp

January 7, 2003


DAVID J. WALCZAK
PRIMARY EXAMINER